UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,147	11/03/2003	Robert Sesek	200301153-1	3826

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EXAMINER
LEMMA, SAMSON B

ART UNIT	PAPER NUMBER
2132	

NOTIFICATION DATE	DELIVERY MODE
09/29/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Rce filed on 09/04/08*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6,13,20-22 and 32-36* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6,13,20-22 and 32-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   The request filed on September 04, 2008 for a request for continued

examination (RCE) under 37 CFR 1.114 based on patent application

10/700,147 is acceptable and an RCE has been established. Claims 2, 5,

7-12, 14-19 and 23-31 are canceled. New claims 32-36 are added. Thus

claims 1, 3-4, 6, 13, 20-22 and 32-36 are pending of which claims 1,

20, 32 and 36 are independent claims.

Priority

2.   This application does not claim priority. Therefore, the effective filling

data for the subject matter defined in the pending claims of this

application is **11/03/2003.**

Response to Arguments

3.   Applicant's remarks/arguments filed on September 04, 2008 have been

fully considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made

in this Office action:

A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent,
> published under section 122(b), by another filed in the United States before
> the invention by the applicant for patent or (2) a patent granted on an
> application for patent by another filed in the United States before the
> invention by the applicant for patent, except that an international
> application filed under the treaty defined in section 351(a) shall have the
> effects for purposes of this subsection of an application filed in the United

States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 1, 3, 13, 20, 32, 35 and 36** are rejected under 35 U.S.C. 102(e)

as being anticipated by **Ogilvie et al** (hereinafter referred as **Og**) (U.S.

Patent No. 6,757,713 B1) (filed on: July 18, 2000)

6.   **As per independent claims 1, 20, 32 and 36 Og discloses a method**

for providing recipient-end security for transmitted data[*See column*

15, lines 9-16], **the method comprising:**

●   **Identifying data to be transmitted to a data receiving device**

of a recipient [column 15, lines 10-11, "see the file 206" which is going

to emailed/transmitted to the recipient 202] ;

●   **configuring the identified data on a data transmitting device**

so as to add an executable to the data that, when executed on the

data receiving device verifies that one or both of the recipient and

the data receiving device are authorized to access the transmitted

data; *[See column 15, lines 9-16] (On column 15, lines 9-16, the following*

has been disclosed. "In one embodiment, a message to be emailed is

embedded in an <u>*executable*</u> *(interpretable, etc.) file and the file 206 is*

emailed. When the recipient 202 tries to open the message 206 the

<u>*executable*</u> *portion runs an authentication operation 228. If the recipient*

202 is authorized and the message file 206 has not already been opened,

then an <u>*executable*</u> *portion 214 of the file 206 and/or a conventional part*

of the recipient station 226 displays 232 the message"]

- **transmitting the identified data and the executable from the data transmitting device to the data receiving device;**[Column 15, lines 9-11]

- **the executable executing on the data receiving device and determining: if the transmitted data may be accessed by the recipient; [column 15, lines 11-16]** *(on column 15, lines 11-16, the following has been disclosed. "When the recipient 202 tries to open the message 206 the executable portion runs an authentication operation 228. If the recipient 202 is authorized and the message file 206 has not already been opened, then an executable portion 214 of the file 206 and/or a conventional part of the recipient station 226 displays 232 the message") and*

- **the executable denying access to the transmitted data it it is determined that the transmitted data may not be accessed.**[See column 15, lines 11-16] *(on column 15, lines 11-16, the following has been disclosed. "When the recipient 202 tries to open the message 206 the executable portion runs an authentication operation 228. If the recipient 202 is authorized and the message file 206 has not already been opened, then an executable portion 214 of the file 206 and/or a conventional part of the recipient station 226 displays 232 the message" Meaning if the recipient 202 is not authorized the authentication would fail and would not be able to open the message meets the limitation of "denying access to the transmitted data.")*

7.   **As per dependent claim 3 Og discloses a method as applied to claims above. Furthermore Og discloses the method wherein determining if the transmitted data may be accessed comprises the executable verifying recipient-specific security information be provide by a recipient.** *[See column 15, lines 9-16 and see particularly the authentication operation 228]*

8.   **As per dependent claim 13 Og discloses a method as applied to claims above. Furthermore Og discloses the method further comprising, if it is determined that the transmitted data may be accessed, printing out the transmitted data or opening an email attachment that comprises the transmitted data.** *[See column 15, lines 9-16] (On column 15, lines 9-16, the following has been disclosed. "In one embodiment, a message* **to be emailed** *is embedded in an* <u>executable</u> *(interpretable, etc.) file and the file 206 is emailed. When the recipient 202 tries to open the message 206 the* <u>executable</u> *portion runs an authentication operation 228. If the recipient 202 is authorized and the message file 206 has not already been opened, then an* <u>executable</u> *portion 214 of the file 206 and/or a conventional part of the recipient station 226 displays 232 the message"]*

9.   **As per dependent claim 35 Og discloses a method as applied to claims above. Furthermore Og discloses the method wherein the executable program is configured to deny to the recipient access to the identified data if authorization to access the identified data is not verified.** *[See column 15, lines 9-16] (On column 15, lines 9-16, the*

*following has been disclosed. "In one embodiment, a message **to be***

***emailed** is embedded in an <u>executable</u> (interpretable, etc.) file and the file*

206 is emailed. When the recipient 202 tries to open the message 206 the

<u>executable</u> portion runs an authentication operation 228. If the recipient

202 is authorized and the message file 206 has not already been opened,

then an <u>executable</u> portion 214 of the file 206 and/or a conventional part

of the recipient station 226 displays 232 the message". Meaning if the

recipient 202 is not authorized the authentication would fail and would not

be able to open the message meets the limitation of "denying access to the

transmitted data.)

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the

basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically
disclosed or described as set forth in section 102 of this title, if the
differences between the subject matter sought to be patented and the
prior art are such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having ordinary
skill in the art to which said subject matter pertains. Patentability shall
not be negatived by the manner in which the invention was made.

11.   **<u>Dependent claims 4, 6, 21-22 and 33-34,</u>** are rejected under 35 U.S.C.

103(a) unpatentable over **Ogilvie et al** (hereinafter referred as **Og**) (U.S.

Patent No. 6,757,713 B1) (filed on: July 18, 2000) in view of Chang et al

(hereinafter referred as **Chang)** (U.S. Publication No. 2002,0083121 A1)

(Published on Jun 27, 2002)

12.   **As per dependent claims 4, 6, 21-22 and 33-34 Og** discloses a

method for providing recipient-end security for transmitted data[

See column 15, lines 9-16], **the method comprising:**

●   **Identifying data to be transmitted to a data receiving device**

of a recipient [column 15, lines 10-11, "see the file 206" which is going

to emailed/transmitted to the recipient 202] ;

●   **configuring the identified data on a data transmitting device**

so as to add an executable to the data that, when executed on the

data receiving device verifies that one or both of the recipient and

the data receiving device are authorized to access the transmitted

data; *[See column 15, lines 9-16] (On column 15, lines 9-16, the following*

has been disclosed. "In one embodiment, a message to be emailed is

embedded in an <u>*executable*</u> *(interpretable, etc.) file and the file 206 is*

emailed. When the recipient 202 tries to open the message 206 the

<u>*executable*</u> *portion runs an authentication operation 228. If the recipient*

202 is authorized and the message file 206 has not already been opened,

then an <u>*executable*</u> *portion 214 of the file 206 and/or a conventional part*

of the recipient station 226 displays 232 the message"]

●   **transmitting the identified data and the executable from the**

data transmitting device to the data receiving device;[Column 15,

lines 9-11]

●   **the executable executing on the data receiving device and**

determining: if the transmitted data may be accessed by the

recipient; [column 15, lines 11-16] *(on column 15, lines 11-16, the*

following has been disclosed. "When the recipient 202 tries to open the

message 206 the <u>executable</u> portion runs an authentication operation 228.

If the recipient 202 is authorized and the message file 206 has not already

been opened, then an <u>executable</u> portion 214 of the file 206 and/or a

conventional part of the recipient station 226 displays 232 the message")

and

- **the executable denying access to the transmitted data it it is**

determined that the transmitted data may not be accessed.[See

column 15, lines 11-16] *(on column 15, lines 11-16, the following has*

been disclosed. "When the recipient 202 tries to open the message 206 the

<u>executable</u> portion runs an authentication operation 228. If the recipient

202 is authorized and the message file 206 has not already been opened,

then an <u>executable</u> portion 214 of the file 206 and/or a conventional part

of the recipient station 226 displays 232 the message" Meaning if the

recipient 202 is not authorized the authentication would fail and would not

be able to open the message meets the limitation of "denying access to the

transmitted data.")

> **Og does not** explicitly disclose the limitation such as verifying
>
> recipient specific security information comprises verifying
>
> recipient biometric information which is recited on dependent
>
> claims 4, 21 and 33

> And

> **Og does not** explicitly disclose the limitation such as the
>
> executable verifying one or both of an of the internet protocol (IP)
>
> address and a media access control (MAC) address of the data

receiving device which is recited on dependent claims 6, 22 and 34.

However, in the same field of endeavor **Chang on paragraph 0173 discloses the following which meets the limitation recited above.**

"Authentication step 604 is optional, but may be necessary if, for example, the use of an output device 140 is restricted to a group of users. In this case, the user may have to provide authentication information to identify him/herself as part of the authorized group to use the service. **Examples of authentication methods may include a user's name, password, personal identification number (PIN), ID number, signatures, security keys (physical or digital), biometric, fingerprint, voice, etc. ID number or IP address of the information apparatus 100 may also be used as authentication information. Such authentication information may be provided by the user manually or detected automatically by the output controller 120 or output device 140.**"

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to combine the feature such as requiring recipient-end security such that machine-specific security data or verify recipient-end security information recipient biometric/IP address information prior to enabling access to the

data as per teachings of **Chang** into the method as taught **by Og**

in order to enhance the security of the authentication system

by adding additional verification. [See Chang, paragraph 0173]

Conclusion

13.   The prior art made of record and not relied upon is considered pertinent

to applicant's disclosure.

   a. Reference u on page 4, first paragraph discloses the following.
   As server-based software, Adobe PDF Merchant was designed for easy

integration into existing eCommerce and transaction servers. Using PDF

Merchant, publishers can easily encrypt volumes of Adobe PDF

documents and link the files directly to a seller's Web site. Stored in the

file at the time of encryption, the URL points to the site of a publisher,

author, retailer, or other Web address. If consumers try to open the file

with- out a valid voucher, they are given the option to follow the URL to

learn how to purchase the right m view the document. Publishers also

use PDF Merchant to generate XML-encoded keys that specify the user's

file permissions **(ability to print, annotate, edit, or select text and**

graphics) and the environment in which the document can be used.

Any inquiry concerning this communication or earlier communications from
the examiner should be directed to Samson B Lemma whose telephone
number is 571-272-3806. The examiner can normally be reached on
Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-
3799. The fax phone number for the organization where this application or
proceeding is assigned is 703-873-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information

for published applications may be obtained from either Private PAIR or
Public PAIR. Status information for unpublished applications is available
through Private PAIR only. For more information about the PAIR system,
see http://pair-direct.uspto.gov. Should you have questions on access to the
Private PAIR system, contact the Electronic Business Center (EBC) at 866-
217-9197 (toll-free).

09/12/08

/Samson B Lemma/
Examiner, Art Unit 2132

/Gilberto Barron Jr/
Supervisory Patent Examiner, Art Unit 2132